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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/847,644 | 05/02/2001 | Jared Polis Schutz | Proflowers-P2-01 | 1018 |

7590

06/03/2003

Peter K. Trzyna
P.O. Box 7131
Chicago, IL 60680-7131

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| EXAMINER |
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LAMB, TWYLER MARIE

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| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 06/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,644

Applicant(s)

POLIS SCHUTZ ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 1-27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-27 of copending Application No. 09/776,956. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Mellgren, III et al. (US 6,085,126).

With regard to claims 1, 11 and 21, Mellgren discloses a method for generating an ornamental design on a courier shipping label at a non-courier printer in connection with printing the label for a particular shipment specified on the label (col 3, lines 43-51), the method including the steps of: assigning shipping information signals corresponding to a shipping label for a particular shipment with a digital electrical computer shipping apparatus (central computer system 106) (col 3, lines 58-62); transmitting the shipping information signals corresponding to the shipping label for the particular shipment to a non-courier printer device (which reads on submitting the information to the manufacturing operation) (col 5, lines 56-61); combining the shipping information signals corresponding to the shipping label for the particular shipment with signals corresponding to an ornamental design (col 5, line 50 – col 6, line 2); and printing the shipping label for the particular shipment at the non-courier printer device including an ornamental design (which reads on submitting the information to the manufacturing operation) (col 5, lines 56-61).

With regard to claims 2 and 12, Mellgren also discloses wherein the ornamental design includes a heart (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46).

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With regard to claims 3 and 13, Mellgren also discloses wherein the ornamental design includes a wreath (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46).

With regard to claims 4 and 14, Mellgren also discloses wherein the ornamental design is printed in color (col 5, lines 38-42).

With regard to claims 5 and 15, Mellgren also discloses wherein the ornamental design is a printing of bit map, said bit map not including a logo, shipment, or courier information (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46).

With regard to claims 6 and 16, Mellgren also discloses wherein the ornamental design is a first design and said first design includes a second design . (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46)

With regard to claims 7 and 17, Mellgren also discloses further including the step of controlling addition of the design to the shipping label at an ordering system computer (which reads on a kiosk coupled to a central computer system via a network) (kiosk 102, col 3, lines 55-62).

With regard to claims 8 and 18, Mellgren also discloses further including the step of controlling addition of the design to the shipping label at an ordering center system computer (which reads on a kiosk coupled to a central computer system via a network) (kiosk 102, col 3, lines 55-62).

With regard to claims 9 and 19, Mellgren also discloses further including the step of controlling addition of the design to the shipping label at a financial institution system

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computer (which reads on a kiosk coupled to a central computer system via a network) (kiosk 102, col 3, lines 55-62).

With regard to claims 10 and 20, Mellgren also discloses further including the step of controlling addition of the design to the shipping label at a distribution center system (which reads on a kiosk coupled to a central computer system via a network) (kiosk 102, col 3, lines 55-62).

With regard to claim 22, Mellgren also discloses wherein said at least two members are printed on the same sheet (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46).

With regard to claim 23, Mellgren also discloses wherein all said members are printed on the same sheet (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46).

With regard to claim 24, Mellgren also discloses further including the steps of: combining ornamental design signals with signals for printing another member of the group (which reads on creating a custom design, the design could be anything) (col 3, lines 43-46); and printing the member of the group, including the ornamental design, for the particular shipment at the shipper printer device (which reads on submitting the information to the manufacturing operation) (col 5, lines 56-61).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

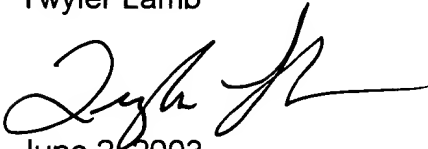
(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

Twyler Lamb



June 2, 2003